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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,467	12/04/2001	Keith D. Allen	R-758	7217

7590 03/26/2003

DELTAGEN, INC.  
740 Bay Road  
Redwood City, CA 94063

EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 03/26/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/005,467

Applicant(s)

ALLEN, KEITH D.

Examiner

Celine X Qian

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-27 are pending in the application.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 14-23, drawn to a PTP36 targeting construct, a method of making said construct, a cell comprising a disruption of a PTP36 gene, a non-human transgenic animal comprising a disruption of a PTP36 gene, and a method of making said transgenic mouse, classified in class 536, subclass 23.1, class 435, 325, class 800, subclass 18.
- II. Claims 10 and 24, drawn to a method of identifying agents that modulates the expression or function or a phenotype associated with the disruption of a PTP36 gene by using a transgenic non-human animal comprising a disruption of a PTP36 gene, classified in class 800, subclass 3.
- III. Claims 11 and 12, drawn to a method of identifying agents that modulates the expression or function or a phenotype associated with the disruption of a PTP36 gene by using a cell comprising a disruption of a PTP36 gene, classified in class 435, subclass 325.
- IV. Claim 13, drawn to an agent that modulates the expression or function of a PTP36 gene, unclassifiable.
- V. Claim 25, drawn to an agent that ameliorates a phenotype associated with a disruption of a PTP36 gene, unclassifiable.

- VI. Claim 26, drawn to an agonist or antagonist of PTP36, classified in class 504, subclass 103.
- VII. Claim 27, drawn to an electronic database comprising the phenotypic data of a PTP36 knockout mouse, classified in class 707, subclass 100.

The inventions are distinct, each from the other for following reasons.

The inventions of Groups I and IV-VII are patentably distinct because the inventions are drawn to materially distinct compositions that are not related. The transgenic animal, the agents, the agonist and the database are biologically, chemically and functionally distinct from each other. Therefore, the inventions of Groups I and IV-VII are patentably distinct.

The inventions of Groups II and III are patentably distinct because they are drawn to methods that require different starting materials and modes of operation. Each method has a distinct purpose and further comprising distinct method steps. Therefore, the inventions of Groups II and II are patentably distinct.

The inventions of Groups I, IV-VII are patentably distinct from the inventions of Groups II and III because the inventions are drawn to compositions and method that are not directly related. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different function, and different effects each from the other. The products of Groups I, VI-VII can be used in methods that require different technical considerations and materially different reagents from the method of Groups II and III. The product of Groups IV and V can be made by methods other than the methods of Groups II and III. For example, the

transgenic animals of Group I may be used to produce antibodies. Further, the method of Group III may be practiced with a wild type animal, and the agent of Groups IV and V can be identified by using a wild type animal. Therefore, the inventions of Groups I, VI-VII are patentably distinct from the inventions of Groups II and III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. A search of the subject matter of one invention would not be co-extensive with a search of the other invention, and therefore the search would be burdensome. Each invention is capable of supporting a separate patent.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.  
March 21, 2003

*Gerald G. Letters*  
PATENT EXAMINER  
*Gerald G. Letters v.*  
*A. 4. 1636*